

Serial No.: 09/714,844
Response to OA of 8/25/04

Remarks

In the present response, eleven claims (1-4, 10, 12, 15-18, 21, 23) are amended, and seventeen claims (26-42) are newly added. Claims 1-42 are presented for examination. Applicant believes that no new matter is entered.

I. Drawing Objections

The drawings are objected to as failing to comply with provisions of 37 CFR 1.84. Applicant amends the specification to add correct reference numerals that correspond with the drawings. Applicant further amends the specification to recite that the controlled-access network 310 has a personal computer (PC) 306, a workstation 307, a printer 308, and a server 309. These elements are clearly shown in Figure 3. No new matter is entered.

In light of the amendments to the specification, Applicant respectfully asks withdrawal of the objections to the drawings.

II. Claim Objections

Claims 2 and 16 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The claims are amended to cure this objection.

Claim 23 is objected to because of informalities. Claim 23 is amended to cure the informalities.

III. Claim Rejection: 35 USC § 112

A. Claims 1-22 are rejected under 35 USC § 112, second paragraph, for lacking antecedent basis. Applicant has amended the claims to address each of the rejections under § 112:

Claim 1 is amended to provide antecedent basis for an "email message."

Claim 10 is amended to recite "a" controlled-access network.

Claim 15 is amended to provide antecedent basis for an "email message" and a "second workstation."

Claim 18 is amended to recite a "mail server."

Serial No.: 09/774,844
Response to OA of 8/25/04

B. Claims 1-14 are rejected under 35 USC § 112, second paragraph.
Applicant has amended the claims to address each of the rejections under § 112:
Claim 1 is amended to remove the word "and" as suggested in the Office Action.

IV. Claim Rejections: 35 USC § 102

Claims 1, 4, 6-9, 12, 15, 18, and 20-21 are rejected under 35 U.S.C. §102 as being anticipated by USPN 5,680,461 (McManis). Applicant respectfully traverses.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since McManis neither teaches nor suggests each element in claims 1, 4, 6-9, 12, 15, 18, and 20-21, these claims are allowable over McManis.

Claims 1, 4, 6-9, 12, 15, 18, and 20-21 recite numerous recitations that are not taught or suggested in McManis. By way of example, claim 1 recites "determining, by said second workstation, if an executable command is within a script of the email message." As another example, claim 15 recites "means for verifying an authorization of said first workstation to request execution, at said second workstation, of a selected function included in a script in the email message." These recitations are neither taught nor suggested in McManis.

A dependent claim inherits the limitations of a base claim. Thus, for at least the reasons given in connection with claims 1 and 15, dependent claims 4, 6-9, and 12 (depending from claim 1) and dependent claims 18 and 20-21 (depending from claim 15) are allowable over McManis.

V. Claim Rejections: 35 USC § 103

Claims 5 and 19 are rejected under 35 USC § 103(a) as being unpatentable over McManis. Applicant respectfully traverses.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the

Serial No.: 09/774,844
Response to OA of 8/25/04

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See M.P.E.P. § 2143.* Applicant asserts that the rejection does not satisfy these criteria.

As discussed in connection with Section IV, McManis fails to teach or suggest all of the limitations of independent claims 1 and 15. Claim 5 depends from claim 1, and claim 19 depends from claim 15. Thus, for at least the reasons given in connection with claims 1 and 15 in Section IV, dependent claims 5 and 19 are allowable.

VI. Claim Rejections: 35 USC § 103

Claims 2-3, 13-14, 16-17, and 22-25 are rejected under 35 USC § 103(a) as being unpatentable over McManis in view of USPN 5,710,883 (Hong). Applicant respectfully traverses.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See M.P.E.P. § 2143.* Applicant asserts that the rejection does not satisfy these criteria.

As discussed in connection with Section IV, McManis fails to teach or suggest all of the limitations of independent claims 1 and 15. Hong fails to cure these deficiencies. Claims 2-3 and 13-14 depend from claim 1, and claims 16-17 and 22 depend from claim 15. Thus, for at least the reasons given in connection with claims 1 and 15 in Section IV, dependent claims 2-3, 13-14, 16-17, and 22 are allowable over McManis in view of Hong.

Claim 23

In rejecting claim 23, the Office Action states:

Serial No.: 09/774,844
Response to OA of 8/25/04

Not explicitly disclosed by McManis is an email message. However, McManis substantially teaches the use of an email as a subclass of the type of packet. Furthermore, Hong et al. substantially teach the use of an email in fig. 3 in the second step of the box entitled "Transport Notes From Client to WW Server." Therefore, it would have been obvious to a person in the art at the time the invention was made, to modify the method disclosed in McManis to specifically use an email message in place of the packet.

Applicant respectfully disagrees with this analysis. McManis teaches "systems and methods for sending packets of information between subscribers on a network." (Col. 1, lines 4-6). McManis explains that a "task to be performed by a packet object might be to ... deliver an e-mail message." (Col. 1, lines 47-51: Text omitted). Thus, the task of a packet object is to deliver the e-mail message. By contrast, claim 23 recites "an email message **including** a task description." McManis does not teach that the email message itself includes a task description. McManis reinforces this teaching:

Or, if the function performed by executing the main method is to **deliver** an e-mail message, such as creating a spread sheet, the object header may specify that the packet object's subclass is "e-mail." (Col. 5, lines 8-12: Emphasis added).

McManis teaches that the packet object includes an object header that **identifies** the packet object's class. (See Col. 5, lines 13-16). McManis does not teach or suggest that the email message itself includes a task description.

Hong is generally directed to publishing a hypertext file on a world-wide web server by packaging the hypertext file as an e-mail message. (See Abstract, Summary, etc.). Hong fails to cure the deficiencies of McManis. Specifically, Hong does not teach or suggest that an email message can include a task description as recited in claim 23.

For at least these reasons, Applicant submits that claim 23 is allowable over McManis in view of Hong. Claims 24-25 depend from claim 23 and are allowable for at least the same reasons given in connection with claim 23.

Serial No.: 09/774,844
Response to OA of 8/25/04

VII. New Claims

Applicant submits new claims 26-42. These claims have numerous limitations that are not taught or suggested in the art of record. Support for these claims is in the specification; thus, no new matter is added.

By way of example only, claim 29 recites "automatically detecting, by the second workstation, if an executable file is attached to the email." The art of record fails to teach or suggest this limitation.

As another example, claim 37 recites "automatically examining, at the second workstation, the email to determine if an executable instruction is (i) within a body of the email or (ii) within an attachment to the email." The art of record fails to teach or suggest this limitation.

Serial No.: 09/774,844
Response to OA of 8/25/04

CONCLUSION

In view of the above, Applicant believes all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,



Philip S. Lyren
Reg. No. 40,709
Ph: 281-514-8236

CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper, as described herein, is being facsimile transmitted to the United States Patent and Trademark Office at 703-872-9306 on this 25th day of November, 2004.

By Be Henry
Name: Be Henry